

**REMARKS**

Upon entry of this reply, claims 18, 21-23, 25-30, 32, 34-37, 40 and 42-45 will be amended, so that claims 18, 21-23, 25-30, 32, 34-45 will be pending, claims 1-17, 19, 20, 24, 31, 33 and 46 have previously been canceled.

By the amendment herein, claim 18 has been amended to place the claim more in accordance with U.S. practice and to include that the at least one ion is non-toxic with respect to human or animal use. The dependent claims have been amended to make amendments corresponding with independent claim 18 as well as to place the claims more in accordance with U.S. practice. Still further, dependent claims 34 and 42 have been amended to advance prosecution relating to indefiniteness issues raised in the 35 U.S.C. 112, second paragraph, rejection.

The amendments to the claims are supported in the originally filed application, such as in Applicants' specification at page 6, second full paragraph, and page 13, the paragraph beginning at the bottom of the page. Accordingly, the amendment should not be considered to introduce new matter.

Reconsideration and allowance of the application are respectfully requested.

**Statement of Interview**

Applicants express appreciation for the courtesies extended by Examiner Lyle Alexander to Applicants' representative Arnold Turk during a June 15, 2010 personal interview at the Patent and Trademark Office.

During the interview, Applicants' representative discussed Applicants' disclosed and

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claimed subject matter, and the Examiner noted confusion regarding the claim that led to the indefiniteness rejection of claim 18 which led to his raising certain indefiniteness issues with respect to concentration recitations in the claims. The Examiner indicated that his confusion may have been caused by the claim format and therefore revision of claim 18 and the dependent claims was discussed during the interview to even more explicitly recite the claimed subject matter.

With respect to the terminology "standard sea water", the Examiner indicated that this ground of rejection would be withdrawn in view Applicants' disclosure relating thereto.

Regarding "field audit analysis", Applicants' representative pointed to Applicants' specification beginning at the bottom of page 13 where such language is disclosed to permit field use of sensors. The Examiner indicated that he understands that sensors can be used in the field but would prefer the inclusion of devices in the claims.

Regarding the rejection based upon Patent No. 5,849,590 to Anderson, it was argued that it would not have been obvious to arrive at Applicants' claimed subject matter because there is no teaching or suggestion in Anderson that would lead one having ordinary skill in the art to mark an alcoholic beverage or a perfume let alone in the manner recited in Applicants' claims, and there is no teaching in the prior art used in the rejection that overcomes the deficiencies of Anderson. The Examiner appeared to agree that there are differences with respect to Applicants' recited subject matter. However, the Examiner indicated that he would need to review the amended claims and the prior art.

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### **Information Disclosure Statements**

Applicants note that an Information Disclosure Statement has been filed on February 19, 2010. The Examiner is requested to include an initialed copy of the form submitted therewith listing the cited information with the next communication from the Patent and Trademark Office.

Applicants are submitting on even date herewith a Second Supplemental Information Disclosure Statement. The Examiner is also requested to include an initialed copy of the Form PTO-1449 with the next communication from the Patent and Trademark Office so that the Examiner's consideration of the Supplemental Information Disclosure Statement and the documents cited therein will be of record.

### **Response to Rejection Under 35 U.S.C. 112, Second Paragraph**

In response to the rejection of claims 18, 21-23, 25-30, 32 and 34-45 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, Applicants submit the following.

During the above-noted interview, the Examiner indicated that the rejection regarding the marker concentration would be withdrawn and it was not necessary to submit a written response thereto. In particular, the Examiner indicated that claim 18 may not have been read correctly when preparing the Final Office Action. In this regard and as noted above, the claims have been amended in accordance with suggestions made during the interview to even more explicitly recite Applicants' claimed subject matter.

With regard to the terminology "standard sea water", it was pointed out during the above-

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noted interview that "stand sea water" is defined in the originally filed application at pages 6-9. The Examiner indicated that this ground of rejection would be withdrawn.

With regard to claims 42-43, Applicants' submit that the terminology is clear to one having ordinary skill in the art especially in view of the discussion in the Applicants' specification beginning at the bottom of page 13. In any event, claim 42 has been amended to include one preferred type of measurement device, e.g., an electrochemical sensor, such as an ion-selective electrode, a multi-ion-selective electrode, an ion-selective Field Effect Transistor, etc.

Accordingly, the rejection under 35 U.S.C. 112, second paragraph, should be withdrawn.

#### **Response To Art Based Rejections**

The following rejections are set forth in the Office Action.

Claims 18, 21-23, 25-30, 32 and 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,849,590 to Anderson et al. (hereinafter "Anderson").

In response to this rejection and as discuss with the Examiner during the above-noted interview, Applicants' independent claim 18 is directed to a method for marking a material, wherein said material is an alcoholic beverage or a perfume, the method comprising:

identifying at least one ion selected from ions contained in standard seawater in said material present at an initial concentration level of below 50 ppm, said at least one ion being non-toxic with respect to human or animal use;

incorporating a marking composition comprising said at least one ion that is non-toxic with respect to human or animal use into the material to form a marked material including said at

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least one ion in the marked material at an increased concentration by at least a factor of 3 as compared to the initial concentration level.

In contrast to Applicants' claimed subject matter. Anderson does not teach or suggest (a) at least a material which is an alcoholic beverage or a perfume; (b) does not teach or suggest the marking composition includes the at least one ion which is non-toxic with respect to human or animal use; and (c) does not teach or suggest incorporating at least one ion which is non-toxic in a marking composition that is added to the alcoholic beverage or perfume let alone in the concentration recited in Applicants' independent claim 18.

As set forth in the Detailed Description of the Invention section of Anderson beginning at the bottom of column 3, Anderson is directed to a method for identifying the source of a transported chemical shipment. Anderson discloses that the method employs a non-radioactive chemical isotope which, with the material being transported, is introduced into the storage container prior to the container being loaded onto a freight vessel, and that either non-radioactive chemical elements or non-radioactive inorganic or organic compounds may be employed. Anderson discloses that his invention finds particular applicability for marking chemical samples, and that marking of the sample permits the recipient of the cargoed product to verify that the sample received is identical to the sample that was shipped with the shipment being checked for the presence of the isotopic compound and matching the isotopic compound with the isotopic compound introduced into the storage vessel prior to shipment which is indicative that the shipped chemical is identical to the chemical received. Anderson discloses that his invention has applicability in the shipment of any chemical commodity, regardless of method of shipping

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or chemical structure of the commodity, but specifically discloses that the method has particular applicability in the shipment of crude oil, refined oil, grains, processed and unprocessed chemicals as well as with bulk refined products. Moreover, Anderson discloses that his invention may be employed in the shipment of a pollutant, hazardous material or a toxic material.

Anderson discloses that, as such, his invention has particular applicability in the identification of spilled shipments of spilled oil, pesticides, cyanide based compounds, arsenic containing compounds, dioxin, military chemical agents, military biological agents, naphthalene and biphenols.

As to the chemical substance for tagging, Anderson discloses that the chemical substance may be a non-radioactive isotope of the chemical shipment being transported, and that any element or compound which can be produced with stable isotopes not generally found in nature is suitable for the chemical substance. The substance is labeled with a non-radioactive atom at least one specific site in the molecule. Particularly preferred by Anderson are those compounds deuterated or rendered isotopic by carbon-13 or fluorine-19. Also preferred are nitrogen-15, oxygen-17 and oxygen-18 isotopic materials.

Anderson specifically discloses that the chemical substance is more commonly a non-radioactive isotope of such organic solvents as acetone, acetonitrile, benzene, bromobenzene, chlorobenzene, chloroform, cyclohexane, dichlorobenzene, trichloroethylene, diethylether, diglyme, dimethylsulfoxide, dioxane, ethanol, methanol, methylene chloride, nitrobenzene, octane, pyridine, tetrachloroethane, tetrahydrofuran, tetrametholsilane, toluene, trifluoroacetic acid, trifluoroethyl alcohol, xylene, ammonium bromide, or acetyl chloride. Moreover, Anderson

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discloses that common inorganic deuterated solvents include deuterium oxide, ammonium deuterioxide, and deuterated ammonium sulfate. In addition, the non-radioactive isotope may be derived from an organometallic material. Isotopes of organometallic and inorganic compounds may include those containing iron-57, europium-151, and tin-119.

All of the Examples of Anderson are also directed to crude oil with Example 1 including deuterated octane, Example 2 including deuterated acetone, and Example 3 including tetrafluorethylene, chloroform and trichloroethylene in a ratio of 1:3:7.

The rejection contends that, "Anderson et al. teach a method of tagging a material using cations of the rare elements that include the claimed cations nickel, cobalt, lithium, copper, cesium, etc." Moreover, the rejection contends that, "Anderson teach in column 4 lines 35-59 the tagging materials can be carbon-13, fluorine-19, oxygen-18, oxygen-19, ammonium bromide and iron-57." **However, the rejection does not establish that such disclosure in Anderson would lead one having ordinary skill in the art to modify Anderson to identify at least one ion selected from ions contained in standard seawater in the material present at an initial concentration level of below 50 ppm, the at least one ion being non-toxic with respect to human or animal use. The rejection has not established that any of the tagging agents disclosed in Anderson are present in standard sea water. Moreover, the rejection does not establish that one having ordinary skill in the art would have identified any tagging agents disclosed in Anderson in an alcoholic beverage or perfume. Still further, the rejection does not provide any teaching or suggestion for incorporating a marking composition comprising the at least one ion that is non-toxic with respect to human or animal use into**

**the material to form a marked material including said at least one ion in the marked material at an increased concentration by at least a factor of 3 as compared to the initial concentration level.**

The rejection improperly points to column 1, lines 58-66 of Anderson for disclosure that sea water is a good composition to be used as a taggant. Anderson discloses at this location that it has also been proposed to use certain non-radioactive tracers in reservoir characterization studies to determine fluid residence times and conductive fluid flow paths. However, Anderson discloses that in such applications, the tracer is detected in salt water, and that salt water is a very simple chemical composition and it is easy to obtain a low detection threshold because there are not many interfering materials. **Thus, salt water is disclosed in Anderson and the salt water is the marked material and not the tagging material as asserted in the rejection.**

The rejection further admits that Anderson is silent to tagging alcoholic beverages and perfumes, but contends that it is well settled the simple substitution of one known element for another to obtain predictable results is within the skill of the art. The rejection contends that Anderson teaches a well known method for the determination of the origin of a product; that it is desirable to determine the origin or authenticity of other liquids that are susceptible to adulteration, such as alcoholic beverages and perfumes; and that it would have been within the skill of the art to use a known method of tagging, such as that taught by Anderson, to tag other materials, such as alcoholic beverages or perfumes, to achieve the well known and expected results of determining the origin or authenticity of the material.

In contrast to these assertions, **Applicants note that the rejection does not include any documentary evidence with respect to any type of tagging of either alcoholic beverages or perfumes.** Applicants respectfully submit that an obviousness rejection cannot be supported by mere allegations that it would have been obvious to arrive at Applicants' invention. The Examiner is reminded that a rejection must be based upon documentary evidence, and not merely official notice. In this regard, the Examiner's attention is directed to MPEP 2144.03 wherein it is noted that, "If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position". In the instant situation, Applicants respectfully submit that the rejection is improper as not utilizing documentary evidence to support the position taken in the rejection. The rejection merely makes an assertion of obviousness, but does not support this assertion by documentary evidence. There is not the slightest documentary evidence to arrive at Applicants' disclosed and claimed invention.

Thus, in the event that the rejection is maintained, Applicants request that the rejection be modified to include documentary evidence supporting the position taken in the rejection.

Moreover, attention is directed to In re Ahlert and Kruger, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970), which is cited in MPEP 2144.03. In Ahlert, at 165 USPQ 421, it is stated that:

Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching. The facts so noticed serve to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. We know of no case in which facts judicially noticed comprised the principal evidence upon which a rejection was based or were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used.

In the instant case, the rejection improperly utilizes assertions of obviousness, which can at best be characterized to be considered Official Notice, not to “fill in the gaps”, but to provide a complete reasoning behind modification of the primary reference. Accordingly, Applicants submit that it is improper to make such naked assertion in the instant case, and a reference must be utilized in the rejection that not only discloses Applicants’ recited concept, but also provides motivation for modifying Anderson to include Applicants’ recited features. This would afford Applicants an opportunity to address issues of lack of motivation for combining separate disclosures as well as an opportunity to argue against any asserted combination.

Moreover, the rejection contends that the incorporating a marking composition comprising said at least one ion at an increased concentration by at least a factor of 3 as compared to the initial concentration level is a mere matter of optimization in Anderson. However, the rejection does not address why such matter is a mere optimization when Anderson specifically discloses at column 7, lines 64-66, the desirability of eliminating the need for quantitatively analyzing for the tagging agent and greatly simplifies the invention.

Still further, the rejection contends that:

Applicants state Anderson teaches tagging to determine the origin of the sample and does not teach the claimed “identifying the authenticity”. These remarks are only commensurate in scope with independent claims 30 and 37 and there dependent claims. With respect to these claims, the Office maintains that it is notoriously well known in the art that determination of the origin of a product is how authenticity is determined. If the product is not from the expected origin, then the product is counterfeit. Additionally, the Office has cited Empedocles(US 2004/0026684) to establish that it is notoriously well known in the art to correlate the origin of a material with the materials authenticity. Specifically, Empedocles teaches in paragraph[0196] the point of origin of the product is used to distinguish if the product is counterfeit.

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With regard to these assertions, Applicants submit that the rejection does not establish that Anderson discloses other than product tracking or liability for environmental wrongdoing. The rejection appears to once again rely on Official Notice and does not properly use any other documentary evidence in the rejection to establish that the process of Anderson can be modified to arrive at the subject matter recited in Applicants' claims. Therefore, the rejection should be withdrawn, and if maintained be modified with appropriate documentary evidence in the rejection to support the Examiner's position.

Accordingly, for at least the reasons set forth above, the rejection should be withdrawn.

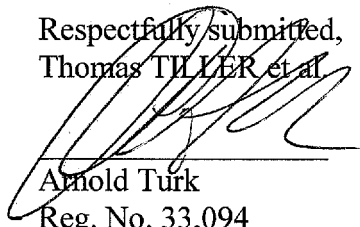
Still further, the dependent claims are patentable for the reasons set forth above as well as for the combination of features recited in the dependent claims.

Therefore, the rejections of record should be withdrawn for each of the pending claims, and each of the pending claims indicated to be allowable over the prior art of record.

**CONCLUSION**

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance. Accordingly, an early issuance of the Notices of Allowance or Allowability is again respectfully solicited. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,  
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